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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,780	11/04/2003	Sue Feng	5725.0895-02	5902

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EXAMINER

VENKAT, JYOTHSNA A

ART UNIT

PAPER NUMBER

1615

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/10/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/699,780

Applicant(s)

FENG ET AL.

Examiner

JYOTHSNA A. VENKAT Ph. D

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 95,97,98,101,123,135,142,167,170,175,192,194 and 203-206 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 95,97,98,101,123,135,142,167,170,175,192,194,203,205 and 206 is/are rejected.
- 7) ☒ Claim(s) 204 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 12/27/06
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Receipt is acknowledged of IDS filed on 12/27/06. Claims 1-95, 99-100, 102-122, 124-134, 136-141, 143-166, 168-169, 171-174, 176-191, 193 and 195-202 are canceled. Claims 95, 97, 98, 101, 123, 135, 142, 167, 170, 175, 192, 194, and 203-206 are pending in the application and the status of the application is as follows:

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/27/06 has been entered.

Information Disclosure Statement

Foreign patents, which are not in English and that, do not have corresponding U. S. equivalents or English equivalents have been considered to the extent that it reads only on the abstract. Upon further review of the claims and the specification, prosecution has been resumed.

Claim Rejections - 35 USC § 112

Claims 95, 97, 98, 101, 123, 135, 142, 167, 170, 175, 192, 194, and 203, and 205-206 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for providing intense color using the specific polymer (species) of claim 204, does not reasonably provide enablement for providing intense color using (i) at least one heteropolymer comprising a polymer skeleton which comprises at least one hydrocarbon-based repeating unit comprising at least one hetero atom or one heteropolymer is chosen from polyamide polymers of formula (I);

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The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.

There are many factors to be considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is “*undue*”. See *In re Wands*, 858 F.2d 731, 737, 8 USPQ 2d 1400, 1404 (Fed. Cir. 1998). The court set forth the eight factors to consider when assessing if a disclosure would require undue experimentation. Citing *Ex parte Forman*, 230 USPQ 546, the court recited eight factors

These factors include, but are not limited to:

- 1) *The breadth of the claims,*
- 2) *The nature of the invention,*
- 3) *The state of the prior art,*
- 4) *The level of one of ordinary skill,*
- 5) *The level of predictability in the art,*
- 6) *The amount of direction provided by the inventor,*
- 7) *The existence of working examples*
- 8) *The quantity of experimentation needed to make or use the invention based on the content of the disclosure.*

(1 and 2) *The breadth of the claims and the nature of the invention*: The claims are drawn to:

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Claim 96 (Previously presented): A method of providing intense color to a composition chosen from one or more of mascara, an eyeliner, a foundation, a lipstick, a blusher, a make-up removing product, a make-up product for the body, an eyeshadow, a face powder, a concealer, a shampoo, a conditioner, an anti-sun product, a care product for skin, a care product for lips, and a care product for hair comprising including in said composition:

(i) at least one heteropolymer comprising a polymer skeleton which comprises at least one hydrocarbon-based repeating unit comprising at least one hetero atom; and

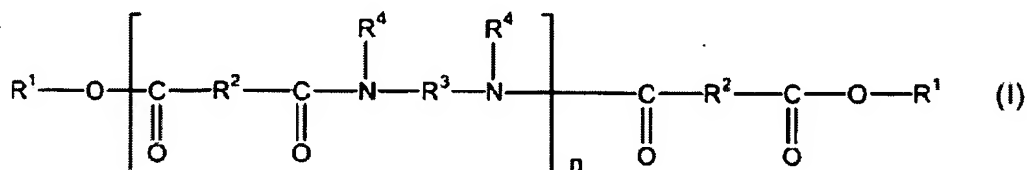
(ii) at least one coloring agent,

wherein said at least one heteropolymer is included in said composition in an amount effective to provide said intense color.

or

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Claim 123 (Original): The method according to claim 96, wherein said at least one heteropolymer is chosen from polyamide polymers of formula (I):



in which:

- n is an integer which represents the number of amide units such that the number of ester groups present in said at least one polyamide polymer ranges from 10% to 50% of the total number of all ester groups and all amide groups comprised in said at least one polyamide polymer;
- R¹, which are identical or different, are each chosen from alkyl groups comprising at least 4 carbon atoms and alkenyl groups comprising at least 4 carbon atoms;
- R², which are identical or different, are each chosen from C₄ to C₄₂ hydrocarbon-based groups with the proviso that at least 50% of all R² are chosen from C₃₀ to C₄₂ hydrocarbon-based groups;
- R³, which are identical or different, are each chosen from organic groups comprising atoms chosen from carbon atoms, hydrogen atoms, oxygen atoms and nitrogen atoms, with the proviso that R³ comprises at least 2 carbon atoms; and
- R⁴, which are identical or different, are each chosen from hydrogen atoms, C₁ to C₁₀ alkyl groups and direct bonds to at least one group chosen from R³ and another R⁴ such

that when said at least one group is chosen from another R⁴, the nitrogen atom to which both R³ and R⁴ are bonded forms part of a heterocyclic structure defined in part by R⁴-N-R³, with the proviso that at least 50% of all R⁴ are chosen from hydrogen atoms.

or

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Claim 205 (Previously presented): The method according to claim 203, wherein the at least one heteropolymer is chosen from ethylenediamine/stearyl dimer dilinoleate copolymer.

(6-7) The amount of direction provided by the inventors and the existence of working

examples: Applicants have provided in the specification one tables which shows method providing color using one species belonging to formula I. See below for test results.

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[00125] EXAMPLES.

[00126] The following compositions were prepared and their gloss and color were evaluated.

INCI Name	Inventive Composition	Comparative Composition
A		
Preservative	1.40	1.40
Film Formers	7.40	7.40
Thickening agent	0.10	0.10
Humectant	2.00	2.00
Triethanolamine	1.50	1.50
Anti-foam agent	0.10	0.10
B		
Waxes	10.75	17.02
Glyceryl Stearate	4.00	4.00
Stearic acid	3.00	3.00
Ethylenediamine/ Tall oil dimer acid/ Stearyl alcohol copolymer	6.27	--
Black Pigment	6.00	6.00
C		
Dimethicone copolyol	0.30	0.30
Cyclopentasiloxane	2.00	2.00
Cyclopentasiloxane/ Dimethiconol	3.00	3.00
Fillers	3.00	3.00
Conditioning agents	0.70	0.70

[00127] The components of phase A, except for the pigment, were blended together in water and the mixture was heated to a temperature ranging from 90°C to 95°C. Once

the waxes had melted, the pigment was dispersed into the mixture with stirring.

Separately, the components of phase B were blended together in water and the mixture was heated to a temperature ranging from 95°C to 100°C. The two mixtures were then combined with agitation and the combination was homogenized. The combined mixture was then cooled to a temperature ranging from 60°C to 65°C, and the components of phase C were added.

[00128] The gloss and the color of the inventive composition comprising at least one heteroatom (ethylenediamine/tall oil dimer acid/stearyl alcohol copolymer) and the comparative composition were evaluated and compared as follows. The gloss and the color of each of the compositions were visually evaluated by spreading a similar amount of each composition onto a piece of white paper. The color of the inventive composition was observed to be much more intense than the color of the comparative composition. Further, the inventive composition was observed to be much glossier than the comparative composition indicating greater dispersion of the pigment in the inventive composition.

Only one species was tested.

(8) The quantity of experimentation needed to make or use the invention bases on the content of the disclosure: The claims recite hetero polymer comprising polymer skeleton. This includes myriad of polymers. The same is true for polymers of formula I. The instant specification gives one skilled in the art no indication that the one could use the any polymer of claim 96 or all the polymers of formula I and have a reasonable expectation of success using the polymer and coloring agent only. Therefore further

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testing would be necessary to use the claimed invention and the practice of the full scope of the invention would require undue experimentation.

Allowable Subject Matter

Claim 204 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT Ph. D whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30:1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL WOODWARD can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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JYOTHSNA A VENKAT Ph. D
Primary Examiner
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